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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,139	06/29/2001	James P. Beck	13615.25USU4	5466

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EXAMINER

RAYMOND, RICHARD L

ART UNIT PAPER NUMBER

1624

DATE MAILED: 01/14/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/896,139

Applicant(s)

BECK ET AL.

Examiner

Richard L. Raymond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2003 and 17 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-221 is/are pending in the application.
- 4a) Of the above claim(s) 26-144 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 145-221 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>9</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election

1. Pursuant to the requirement for election of species, applicants have elected the compound of Example 6, and proposed a generic concept for examination. Claims 1-25 and 145-221 read on the elected species. Claims 26-144 do not read on the elected species. The following restriction requirement is presented with Group I being elected and claims 26-144 withdrawn from further consideration.

Requirement for Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-25 and 145-221, drawn to substituted amines of formula X and methods of use, classified in class 514, subclass 620.
 - II. Claims 26-47, drawn to protected compounds of formulas III and IV, classified in class 564, subclass 502.
 - III. Claims 48-57, drawn to epoxides of formula V, classified in class 549, subclass 552.
 - IV. Claims 58-94, drawn to compounds of formulas VII, VIII and VIX, classified in class 564, subclass 502.
 - V. Claims 95-104 and 115-122, drawn to azides of formulas XII and IIV, classified in class 552, subclass 11.

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- VI. Claims 105-114, drawn to protected amines of formula XIII, classified in class 564, subclass 503.
- VII. Claims 123-133, drawn to azides, classified in class 522, subclass 11.
- VIII. Claims 134-144, drawn to free amines of formula XVI, classified in class 564, subclass 503.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II-VIII are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as herbicides and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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Improper Markush Rejection

5. Claims 1-5 and 145-221 are rejected as being improper Markush claims in the definition of the R_N and R_1 variables. So substituted, the resulting total compounds lack a common core and are structurally diverse and patentably distinct one from the others. A reference anticipating one under 35 USC 102 would not be a reference against the others under 35 USC 103. Diverse fields of search in subclasses in classes 514, 549, 552 and 564 and in STN/CAS are involved. Applicants in their election suggested a genus of compounds where R_N is (I) $R_{N-1}-X_N$ where R_{N-1} is optionally substituted phenyl and X_N is $-CO-$, R_1 is (VI) optionally substituted benzyl and R_2 , R_3 and R_C are as in claim 1. Limitation of the claims to this genus will overcome the above rejection.
6. The claims have been searched and examined to the extent that they read on the above noted invention.

Allowable Subject Matter

7. Claims 1-25 and 145-221 are allowable over the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard L. Raymond whose telephone number is (703) 308-4523. The examiner can normally be reached on Monday-Thursday (9:30AM-8:00PM)).

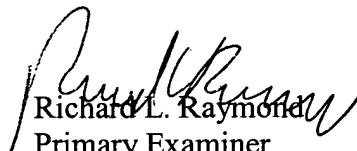
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund J. Shah can be reached on 305-4716. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


Richard L. Raymond
Primary Examiner
Art Unit 1624

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January 12, 2003